

**REMARKS**

Claims 1, 3-6, 8-10, 12, 14, 15 and 19-23 are pending in the application.

Claims 1, 3-6, 8-10, 12, 14, 15 and 19-23 are rejected.

Claim 23 is canceled.

Reconsideration and allowance of claims 1, 3-6, 8-10, 12, 14, 15 and 19-22 is respectfully requested in view of the following:

**The Rejection of Claim 1 as being unpatentable over Sainsbury et al in view of Wilcox et al in further view of Shyr et al;**

**The Rejection of Claim 12 as being unpatentable over Sainsbury et al in view of Hatular in further view of Wilcox et al and in further view of Shyr et al;**

**The Rejection of Claim 22 as being unpatentable over Hatular in view of Sainsbury et al in further view of Wilcox et al and in further view of Shyr et al;**

Claim 1 is rejected under 35 U.S.C. §103(a) as being unpatentable over Sainsbury et al (U.S. Patent 6,104,162) (Sainsbury) in view of Wilcox et al (U.S. Patent 5,994,885) (Wilcox) and in further view of Shyr et al (U.S. Patent 5,903,764) (Shyr). The Examiner has not explicitly stated the basis for rejecting dependent claims 3-6 and 8-10. As such, Applicants have assumed that they have been rejected based upon the same references as independent claim 1 from which they depend.

Claim 12 is rejected under 35 U.S.C. §103(a) as being unpatentable over Sainsbury in view of Hatular (U.S. Patent 6,184,660) (Hatular) in further view of Wilcox and in further view of Shyr. The Examiner has not explicitly stated the basis for rejecting dependent claims 14, 15 and 19-21. As such, Applicants have assumed that they have been rejected based upon the same references as independent claim 12 from which they depend.

Claim 22 is rejected under 35 U.S.C. §103(a) as being unpatentable over Hatular in view of Sainsbury in further view of Wilcox and in further view of Shyr.

Applicants traverse these rejections on the grounds that these references are defective in establishing a *prima facie* case of obviousness by the examiner as is required by MPEP §2142.

Independent claim 1 recites: "...providing a controller module included in an AC-DC adapter and operable to receive the first feedback signal and the second feedback signal..."

Independent claims 12 and 22 recite: "...a controller module included in the AC-DC adapter and operable to receive a first feedback signal input indicative of a target voltage required by a load and a second feedback signal input indicative of the second DC output..."

As the PTO recognizes in MPEP §2142:

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

The USPTO clearly cannot establish a *prima facie* case of obviousness in connection with the amended claims for the following reasons.

35 U.S.C. §103(a) provides that:

[a] patent may not be obtained...if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Thus when evaluating a claim for obviousness all limitations must be evaluated. Independent claim 1 requires "providing a controller module included in an AC-DC adapter and operable to receive the first feedback signal and the second feedback signal" and independent claims 12 and 22 require "a controller module included in the AC-DC adapter and operable to receive a first feedback signal input indicative of a target voltage required by a load and a second feedback signal input indicative of the second DC output." The Examiner argues that Sainsbury discloses "providing a controller module (Figure 5) including in an AC-DC adapter (Figure 3, element 22) and operable to receive the first feedback signal (Column 5, lines 17-21) and the second feedback (signal) (Column 5, lines 1-2)". The Applicants respectfully disagree. The controller module indicated by the Examiner as being disclosed in Figure 5 of Sainsbury (referred to by Sainsbury as a "auto voltage and solid state power monitor" in the Description of the Drawings, Fig. 5) is illustrated in Fig. 3 of Sainsbury as being included in a "housing 22" of a "power module 15". The auto voltage and solid state power monitor includes a "power transistor 33 that is biased...based on...the feedback voltage  $V_{SENSE}$ , which measures the actual voltage delivered to the output connectors" (Column 4, lines 66-67 and Column 5, lines 1-2). The Examiner indicates that the feedback voltage  $V_{SENSE}$  is the second feedback. However, the Examiner argues that the controller module that is operable to receive the first feedback signal is disclosed in Sainsbury at Column 5, lines 17-21, which references Fig. 6 and reads:

"Power monitor 44 monitors the power demand of the tool and power distributor 43 delivers the required power to the tool via connector 45 from a combination of fuel cell and battery power and power received via connector 40."

Fig. 6 illustrates a "multi-functional battery module". The power monitor 44 is included in the multi-functional battery module and is not included in the housing 22 of the power module 15, which the Examiner argues is the AC-DC adapter. Thus, if Sainsbury is applied as suggested by the Examiner, it discloses a first controller module included in an AC-DC adapter and operable to receive a second feedback signal and a second controller module included in a multi-functional battery module (that is separate from the AC-DC adapter) and operable to receive the first feedback signal. Thus, Sainsbury does not disclose "providing a controller module included in an AC-DC adapter and operable to receive the first feedback signal and the second feedback signal", nor "a controller module included in the AC-DC adapter and operable to receive a first feedback signal input indicative of a target voltage required by a load and a second feedback signal input indicative of the second DC output." Wilcox, Shyr, and Hatular disclose nothing to remedy these deficiencies. Therefore, for at least the reasons stated above, independent claims 1, 12 and 22 are submitted to be allowable and Applicants respectfully request that the rejection be withdrawn.

Dependent claims 3-6 and 8-10 depend from and further limit independent claim 1, and dependent claims 12, 14, 15, 19 -21 depend from and further limit independent claim 12, and are submitted to be allowable for at least the reasons stated above. Therefore, Applicants respectfully request that the rejection be withdrawn.

Furthermore, the MPEP §2143.01 provides:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

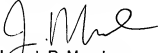
With regard to independent claims 1, 12 and 22, neither Sainsbury, Wilcox, Shyr, nor Hatular provide any suggestion, incentive, or motivation for providing a controller module included in an AC-DC adapter and operable to receive the first feedback signal and the second feedback signal, nor a controller module included in the AC-DC adapter and operable to receive a first feedback signal input indicative of a target voltage required by a load and a second feedback signal input indicative of the second DC output. Dependent claims 3-6 and 8-10 depend from and further limit independent claim 1, and dependent claims 12, 14, 15, 19 -21 depend from and further limit independent claim 12.

Therefore, the Examiner's combination arises solely from hindsight based on the invention without any showing of suggestion, incentive or motivation in any reference for the combination.

Thus, the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejections under 35 U.S.C. §103(a) should be withdrawn.

In view of the above, it is respectfully submitted that claims 1, 3-6, 8-10, 12, 14, 15 and 19-22 are in condition for allowance. Accordingly, an early Notice of Allowance for the remaining claims is courteously solicited.

Respectfully submitted,

  
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